

Remarks

Claims 1-6 were pending. Claims 1, 2, 3, and 5 are amended. Claims 1 and 2 were amended as discussed below. Claims 3 and 5 were amended to change claim dependency. Claim 7 has been added and recites some of the features recited in original claim 2. Support for the amendments can be found in the specification, *inter alia*, at page 7, lines 5-8, page 11, lines 10-11, page 14, lines 24-29, and page 14, line 30 – page 15, line 3, and the original claims. Accordingly, Applicants respectfully submit that no new matter has been added. Claims 1-7 are now pending.

Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration of the outstanding rejections and passage of the claims to allowance.

Objection to the Specification

The specification was objected to because the continuing information contained in the Bibliographic Data Sheet is not included in the specification. Applicants have now amended the specification at the first paragraph to include the required information. Accordingly, Applicants respectfully submit that the objection to the specification has been overcome and that the objection should be withdrawn.

Objection to the Abstract

The Abstract was objected to because an official abstract is required in place of the PCT abstract as filed. Applicants have amended the Abstract to address this objection. Accordingly, Applicants respectfully submit that the objection to the Abstract has been overcome and that the objection should be withdrawn.

Claim Objections

Claims 1, 2 and 5 were objected to for certain informalities and a lack of antecedent basis. Applicants have amended the claims to address the informalities. Therefore, Applicants submit that the objections have been overcome and should be withdrawn.

Objection to the Drawings

The drawings were objected to by the Examiner. Applicants have amended Figs. 15-20 to include the legend --Prior Art--. Accordingly, Applicants respectfully request reconsideration and withdrawal of the drawing objection.

§ 102 and § 103 Rejections

Claims 1 and 2 were rejected under 35 USC § 102(b) as being anticipated by Kim et al (U.S. 5,708,746). Claims 3-6 were rejected under 35 USC § 103(a) as being unpatentable over Kim et al (U.S. 5,708,746). Applicants respond as follows.

With respect to claim 1, Applicants have amended the claim to recite further structure regarding the joint element (see, e.g., the specification, page 7, lines 5-8). Applicants respectfully submit that Kim does not disclose, teach, or suggest a joint element having “two opposing folding members joined at a coupling part and openable between a non hold position where the element does not hold the bare fibers and a hold position where the element holds the bare fibers.” Instead, Kim teaches a flat base panel 12 that holds the fibers in place until a separate clamp 2 having a center embossment 22 contacts the cladding of the fibers positioned in groove 5. See Kim, Figs. 1 and 2C. This panel 12 cannot be folded.

As the claimed structure is completely missing from Kim’s disclosure, Kim cannot anticipate claim 1. Further, there is no suggestion that Kim’s device could have been or would have been modified to accommodate Applicants’ claimed joint element.

Regarding claim 2, Applicants have amended the claim to further recite the features of original claims 3 and 4. As such, a *prima facie* case of obviousness has not been established. In particular, Applicants respectfully submit that Kim does not disclose, teach, or suggest the recited structure of claim 2, namely “wherein each of the buffer retainers has a first tongue-shaped member extending in the extension direction, and an engagement part formed to the first tongue-shaped member in a manner engageable with the pressing part for moving the first tongue-shaped member towards the buffer coating through the movement of the cap in the orthogonal direction” and “wherein the engagement part includes a second projecting member which comes in contact with the first projecting member to move the first tongue-shaped

member towards the buffer coating by movement of the first projecting member in the orthogonal direction.”

In contrast, Kim teaches a structure where multiple clamps (2, 3) are used to clamp portions of the optical fiber that are actuated by an axial movement of covers 4 along rails 7. See Kim, Figs. 1, 5A and 5B, and col.4, lines 15-21. The claimed structure is completing missing from Kim’s disclosure.

Applicants agree with the Office Action, to the extent that it admits that Kim “does not *explicitly* teach tongue-shaped, engagement parts, pressing members that press and hold the optical fibers.” (see Office Action, page 5). With respect to claim 6, Applicants further agree with the Office Action, to the extent that it admits that Kim “does not *explicitly* teach end plugs/caps that extend in the same direction of the optical passages and are fitted integrally with the jacket.” (see Office Action, page 6). However, Applicants further submit that this claimed structure is not *implicitly* taught or suggested either. In fact, there is no suggestion whatsoever provided in Kim’s teaching, or any cited reference, that would have motivated one of ordinary skill in the art to have modified Kim’s device at the time of the invention to produce the structure of the recited optical fiber splicing member.

Applicants respectfully disagree with the statement in the Office Action that Applicants’ device would have been an obvious design choice “because applicant has not disclosed that using tongue-shaped/projecting members/pressing member provides an advantage, is used for a particular purpose, or solves a stated problem.” (see Office Action at page 5). First of all, such a “disclosure” is not a requirement for patentability – rather, the determination of patentability is based on the structure that is recited in the pending claims and determining whether such structure is taught or suggested by the cited references. See MPEP 2143 (“there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference”) Accordingly, the Patent Office cannot base a rejection on the argument that “one of ordinary skill in the art would have expected Applicant’s invention to perform equally well....” when such a claimed structure is not taught or suggested by the cited references. Just because a person of ordinary skill in the art *could* have possibly come up with Applicants’ claimed structure at the time of the invention does

not negate patentability – there must be some evidence of sufficient motivation to modify Kim's device to produce the claimed invention.

Second, Applicants DO provide an explanation for why such a structure is beneficial to splicing –“By employing the above constitution, splicing the bare fibers 191 of the optical fibers 190 and pressing the buffer coatings 192 of the optical fibers 190 can be both achieved by depressing only the cap 140. Further, since it is not necessary to press the cap 140 until it sinks into the jacket 120, a special arrangement to an optical fiber splicing tool, or the like is eliminated, and the conventional splicing tool can be used as it is.” See specification, page 14, line 30 – page 15, line 3. There is no indication in Kim of such a stated problem or the claimed solution.

Accordingly, Applicants respectfully submit that the rejection of claims 1 and 2 under 35 USC § 102(b) as being anticipated by Kim et al and the rejection of claims 3-6 under 35 USC § 103 as being unpatentable over Kim et al have been overcome and should be withdrawn.

For at least the reasons above, Applicants respectfully submit that the pending claims are patentable over the cited art.

Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Please contact the undersigned should there be any questions or in order to expedite prosecution.

Respectfully submitted,

6/08/06
Date

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